

REMARKS

Reconsideration of the present application is respectfully requested.

In the first Office Action the Examiner rejected claims 1-10 under 35 U.S.C. §102(a) as being anticipated by Macnaughtan et al., “NMR Difference Probe,” *Journal of Magnetic Resonance* 156, 97-103 (2002). The Examiner also indicated that Figure 1 should be marked as prior art. In the second Office Action – made final – the Examiner again rejected claims 1-10 as being anticipated by Macnaughtan et al., but this time under 35 U.S.C. §§102(f) and 102(g) instead of §102(a).

It is respectfully submitted that the second action should not have been made final. Second actions on the merits should not be made final if, as in this case, the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement (IDS) filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). MPEP §706.07(a). There was no claim amendment in this case, and no rejection based on information in the IDS. Therefore, in view of the new ground of rejection under §102(f) and §102(g), the finality of the action should be withdrawn.

Moreover, the rejection over Macnaughtan et al. should be withdrawn because the cited reference is a publication of Applicants' own invention. MPEP §§715.01(c) and 716.10. The mere designation of authorship in a published article does not raise a presumption of inventorship with respect to the subject matter disclosed in the article so as to justify a rejection under 35 U.S.C. §102(f). MPEP §716.10. An uncontroverted “unequivocal statement” from the applicant regarding the subject matter disclosed in the article will be accepted as establishing inventorship. *Id.*

Applicants submit herewith a Declaration under Rule 132 in support of the prior assertion that, to the extent that the Macnaughtan et al. article describes the claimed subject matter, it describes Applicants' invention. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection relying on the Macnaughtan et al. article, and withdraw the objection to Figure 1.

The Examiner is invited to call the undersigned attorney if a discussion of any of the outstanding issues might help advance the prosecution of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William F. Bahret", written over a horizontal line.

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